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IN THE

Supreme Court of the United States

OCTOBER TERM 1974

NO. 74-680

DR. JERRY BLUMBERG, O.D., *Petitioner*

v.

BAUSCH AND LOMB OPTICAL COMPANY,
Respondent

RESPONDENT'S BRIEF IN OPPOSITION TO PETITIONER'S PETITION FOR WRIT OF CERTIORARI

W. F. HYER
Attorney for Respondent
900 Eastern Airlines Building
One Greenway Plaza East
Houston, Texas 77046

Alpha Law Brief Co., One Main Plaza, No. 1 Main St., Houston, Texas 77002

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JURISDICTION

Since the judgment here sought to be reviewed by Petitioner is one rendered by a lower Federal Court, this Court has no jurisdiction under 28 U.S.C. 1257(3) as alleged by Petitioner.

STATEMENT OF THE CASE

The most concise statement of the case appears in the Order of the Sixth Circuit Court of Appeals (Appendix A of the Petition).

REASONS FOR NOT GRANTING THE PETITION

I.

This Petition Does Not Involve An Important, But Undecided, Question Of Federal Law

The decision of the Sixth Circuit Court of Appeals involves a question of federal law which has been settled by this Court in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 11 L.ed.2d 661, 84 S.Ct. 784 (1964) and in *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234, 11 L.ed.2d 669, 84 S.Ct. 779 (1964).

Petitioner is seeking an injunction prohibiting Respondent from copying Petitioner's admittedly unpatented spectacle frame and an award of damages by reason of such copying. Petitioner's theme is that his long use of his spectacle frame has in some manner created an exclusive proprietary right (variously alluded to as a "mark", "trademark" or "service mark") protected by the unfair competition law of the State of Michigan. Any question concerning this has been fully answered in the *Sears* and *Compco* cases, supra. The thrust of these two cases is best summarized in *Compco* at 237:

> "Today we have held in Sears, Roebuck & Co. v. Stiffel Co., supra, that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article."

and at page 238:

> "It is true that the trial court found that the configuration of Day-Brite's fixture identified Day-Brite to the trade because the arrangement of the ribbing had, like a trademark, acquired a 'secondary mean-

> ing by which that particular design was associated with Day-Brite. But if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will."
>
> * * * *
>
> "That an article copied from an unpatented article could be made in some other way, that the design is 'nonfunctional' and not essential to the use of either article, that the configuration of the article copied may have a 'secondary meaning' which identifies the maker to the trade, or that there may be 'confusion' among purchasers as to which article is which or as to who is the maker, may be relevant evidence in applying a State's law requiring such precautions as labeling; however, and regardless of the copier's motives, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling."

It is respectfully submitted that Petitioner cannot appropriate an unpatented spectacle frame and then, by virtue of state law or common law, create such proprietary rights in such frame as to afford a monopoly in the market place. If this were the case, then every originator of a new design, not of the dignity to be patentable under the federal patent laws, could create his own private monopoly and thus proliferate a multitude of private areas isolated from direct competition.

II.

The Alleged Conflict In The Courts Of Appeals Decisions

Petitioner has not shown that the instant decision by the Sixth Circuit Court of Appeals conflicts with the decision of another court of appeals on the same matter.

The alleged "conflict" appears to be in the nature of critical comment of various authors directed to the *Sears* and *Compco* decisions.

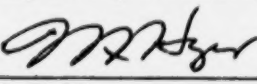
Petitioner has adopted one author's statement about inconsistency between the *Riback Enterprises* decision and that of *Flexitized, Inc.* (Petition, page 12). The court in *Riback* followed *Sears* and *Compco* and refused to enjoin a defendant from selling greeting cards arranged in a format proximating that of the plaintiff. The *Flexitized* case involved a word mark and not an article of commerce such as was in issue in *Sears, Compco* and *Flexitized.* Thus, there is no real inconsistency in these decisions.

Petitioner argues that the instant Sixth Circuit's decision is in conflict with the decision of *In re Mogan David Wine* (Petition, page 18). In *Mogan David,* the issue was whether one federal law (design patent law) should be construed to limit the rights and privileges afforded by another federal law (federal registration of a trademark), i.e., can the federal design patent law be construed to prevent one who has a design patent from registering the subject matter of the design patent as a trademark when the federal trademark law does not prohibit such registration? Petitioner does not have any federal registration nor is he seeking one in this proceeding nor does he have any design patent. Petitioner is seeking an exclusive right to use his spectacle frame by virtue of the state law of unfair competition and is not relying on any federal law. The Sixth Circuit merely followed the mandate of *Sears* and *Compco.*

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,



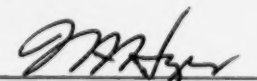
W. F. HYER
900 Eastern Airlines Building
One Greenway Plaza East
Houston, Texas 77046
Attorney for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Respondent's Brief in Opposition to Petitioner's Petition For Writ of Certiorari was mailed first class to the attorney of record for Petitioner herein, by depositing the copy in the United States mail, postage prepaid, addressed to:

Mr. Gerald R. Hershberger
285 E. Long Lake Rd.
Troy, Michigan 48084

this 10 day of January, 1975.



W. F. HYER